

REMARKS

Claims 1-99 were presented for examination.

Claims 1-99 were rejected.

Substance of the interview.

Applicant thanks the Examiner for his time in conducting a brief telephone interview on Mar. 31, 2006. During the telephone interview, Applicant's attorney and the Examiner discussed the rejections based on combining Lemelson's multi-laser system with Sucha's co-propagating beams. Applicant explained that Sucha's co-propagating beams could not be combined with Lemelson's system because Lemelson's system requires intersecting beams. Applicant's understanding is that the Examiner generally agreed during the interview but reserved the right to examine the references in more detail upon submission of this written response. The issue discussed during the interview is presented in more detail below.

Claims 1-99: Combining Sucha with Lemelson would destroy Lemelson's intended function.

Claims 1-99 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Lemelson (US 5,995,866) in view of Sucha (US 6,445,491 B2), sometimes in further combination with additional secondary references. These rejections are respectfully traversed.

Beginning with claim 1, claim 1 concerns an apparatus that delivers multiple laser diagnostic beams in the form of a combined diagnostic beam, "in which said laser diagnostic beams are co-propagating." The primary reference Lemelson does not show or suggest co-propagating beams and, in fact, Lemelson's system teaches away from the use of co-propagating beams because it is based on intersecting beams. Therefore, even if Sucha were to teach co-

propagating beams, Sucha cannot be combined with Lemelson because it would destroy Lemelson's intended function.

In more detail, the Office Action points to Lemelson as a reference that teaches the use of multiple laser beams. Figs. 3 and 4 of Lemelson, for example, show two laser beams (42 and 47, or 42' and 47') that are directed at tissue. However, please note the geometry of these two laser beams.

Referring to Fig. 3, Lemelson expressly states that “[t]wo lasers 41 and 46 are arranged on a suitable support (not shown for purposes of simplicity) and spaced apart from and arranged transverse to each other” (col. 6 ll. 54-56). This geometry “permits[s] the beams 42 and 47 of each laser to scan and intersect substantially at a right-angle (or greater or less than a right-angle) to each other” (col. 7 ll. 2-5). Lemelson goes on to point out that the lasers are not limited to the right angle geometry of Fig. 3. Indeed, “lasers 41 and 46 may also be mounted next to each other, as shown by lasers 41' and 46' in FIG. 4, and operable to scan with the beams 42' and 47' thereof intersecting within volume V₁ disposed at acute angles to each other as shown” (col. 7 ll. 5-8). Thus, different geometries are possible but the laser beams in Lemelson must be positioned so that they intersect at the target position WA where the treatment occurs.

This is clearly explained by Lemelson in the following paragraph where he states:

The lasers 41 and 46 (and 41' and 46') of FIGS. 3 and 4 may be controlled in their operations to automatically scan the fluid, molecules or particles or a fluid containing solid particles in volume V₁ (or V₁) along a plurality of layers or stratum therein within which layers the two beams intersect during the scanning of such respective layers so as to impose on the molecules or matter of each layer the combined effect of the two intersecting beams of radiation. By employing this scanning method, matter or molecules in each layer and in the entire volume so scanned by the two beams may be analyzed and/or reacted on by the combined effect of the radiation of the two intersecting beams. In other words, each of the two intersecting beams of radiation may be generated at an intensity (and frequency) such that when they intersect (in volume V), they will generate and direct radiation to matter or molecule(s) at the point or area of intersection which

impinging radiation, (i.e. the total of the radiation beams 42 and 47) is sufficient to excite the matter or molecules within such area to fluoresce and/or to reflect same to the exclusion of other matter or molecules along the path of the respective beams other than at the area of intersection thereof. Thus all or a selected portion(s) of volume V₁ (or V₁') may be scanned in a three-dimensional scanning operation in which the total volume scanned is divided into a series of separate sheet-like volumes or slices thereof by (computer) deflection controlling the two beams to intersect as they respectively scan within each sheet-like or layer-like volume. col. 7 ll. 9-39.

Lemelson's system scans the volume V one point at a time, with the current point of interest defined by the point of intersection of the laser beams. Since Lemelson's laser beams are required to intersect in order to excite only the material at the point of intersection, Lemelson's system cannot make use of co-propagating laser beams. Even if Sucha (or any other reference) were to teach co-propagating laser beams, the reference cannot be combined with Lemelson because the combination would destroy Lemelson's principle of operation and Lemelson's intended function. MPEP 2143.01, headings V and VI.

Hence, Applicant respectfully submits that independent claim 1 and its dependent claims are patentable over Lemelson and the other cited references. Furthermore, since all of the other claims contain similar limitations, Applicant respectfully submits that the remaining claims are also patentable over Lemelson and the other cited references for the same reason.

Applicant respectfully notes that the reasons given above were presented previously in Applicant's previous response to office action dated June 17, 2005 (the response before the final office action). Therefore, if after considering Applicant's remarks, the Examiner still disagrees, the Examiner is invited to telephone Applicant's attorney in order to advance the prosecution of this case.

[REMAINDER OF PAGE INTENTIONALLY LEFT BLANK]

Applicant believes that the application is in condition for allowance of all claims herein, claims 1-99 as previously presented, and therefore an early Notice of Allowance is respectfully requested. If the Examiner believes that for any reason direct contact with Applicant's attorney would help advance the prosecution of this case to finality, the Examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,

Date: April 3, 2006

By: Michael W. Farn

Michael W. Farn
Attorney for Applicant
Registration No. 41,015

Fenwick & West LLP
Silicon Valley Center
801 California Street
Mountain View, CA 94041
(650) 335-7823 (Tel)
(650) 938-5200 (Fax)